## REMARKS

Claims 1-11 are pending. By this Amendment, claims 1-10 are amended and claim 11 is added. No new matter is involved. Reference is made in this regard, to Applicant's original disclosure, including paragraph No. 0017, which provides adequate support for the amendments to the claims.

Initially, Applicants acknowledge with appreciation the courtesies extended by Examiner Lao to Mr. Webster, their undersigned representative, at the personal interview held on September 2, 2003. Applicants summary of that interview is included in the remarks set forth below.

The previous Office Action objected to the drawing for failing to show the reified device communicating with the responsive device. In response, Applicants filed a proposed amendments to drawing Figs. 1 and 2 and demonstrated that support for the amended drawing exists in Applicants' disclosure as originally filed. The outstanding Office Action approved the drawing changes. Accordingly, Applicants attach replacement sheets that include the approved drawing amendments.

The Office Action makes this application a final Office Action. Applicants respectfully submit that this is premature and that the finality of the Office Action should be withdrawn. The previous Office Action incorrectly applied the Fishkin '540 patent under 35 USC §102(b). This Office Action applies Fishkin under 35 USC §102(e) in the rejection of claims 1 and 5.

Applicants' amendment of claims 1 and 5 did not require the Office Action to change the grounds of the rejection of claims 1 and 5 over Fishkin '540 from 35 USC §102(b) to 35 USC §102(e). The only reason for the change of the statutory basis of the rejection was the realization that Fishkin was not properly applied under 35 USC §102(b) in the first Office

Action. Thus, Applicants' Amendment did not necessitate changing the basis of this rejection.

Accordingly, because the rejection of claims 1 and 5 under 35 USC §102(e) over the Fishkin '540 patent was not necessitated by Applicants' Amendment, this rejection cannot be made final, and the finality of this Office Action should be withdrawn.

Moreover, upon the withdrawal of the finality of the outstanding Office Action, the claims should be entered as a matter of right under 37 CFR §1.111.

The Office Action rejects claim 1 under 35 USC §102(b) as anticipated by U.S. Patent No. 5,444,499 to Saitoh. This rejection is respectfully traversed.

Saitoh fails to disclose or suggest several positively recited features of claim 1, including placing an object relative to the physically manipulatable device wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

Accordingly, the rejection of claim 1 as unpatentable over Saitoh is improper and should be withdrawn.

The Office Action rejects claims 1 and 5 under 35 USC §102(e) as anticipated by U.S. Patent No. 6,160,540 to Fishkin et al. (hereinafter, "Fishkin"). This rejection is respectfully traversed.

Claims 1 and 5 clearly patentably define over Fishkin, which does not disclose, for example, placing an object relative to the physically manipulatable device wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

Accordingly, claims 1 and 5 are patentable over Fishkin.

The Office Action rejects claims 2, 6, 9 and 10 under 35 USC 103(a) as unpatentable over U.S. Patent No. 6,160,540 to Fishkin in view of U.S. Patent No. 5,402,492 to Goodman et al. (hereinafter, "Goodman"). This rejection is respectfully traversed.

In the first place, Neither Fishkin fails nor Goodman disclose, for example, placing an object relative to the physically manipulatable device wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

In the second place, a system administrator is not recited in claims 2, 6, 9 and 10, so the relevance of Goodman in this regard is not clear.

Accordingly, claims 2, 6, 9 and 10 are not rendered obvious by Fishkin and/or Goodman. At least for the aforementioned reasons, the subject matter of claims 2, 6, 9 and 10 is patentable over both Fishkin and Goodman.

The Office Action rejects claims 3, 4, 7 and 8 under 35 USC §103(a) as unpatentable over U.S. Patent No. 6,160,540 to Fishkin in view of U.S. Patent No. 5,845,265 to Woolston. This rejection is respectfully traversed.

In the first place, Neither Fishkin fails nor Woolston disclose, for example, placing an object relative to the physically manipulatable device wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

In the second place, the Office Action fails to establish a proper motivation that would have motivated one of ordinary skill in the art to combine the teachings of Woolston with those of Fishkin. Woolston pertains to selling products to consumers who may charge purchases with a credit card. Fishkin does not deal with selling products to consumers who

may charge purchases with a credit card. Absent such a teaching in Fishkin, there is no proper motivation to use a credit card number as a user asset to be stored in Fishkin.

Instead of providing a reason why one of ordinary skill in the art would have been motivated to combine these references, the Office Action merely states the results of. This omits the essential requirement of a motivation for one to have looked to Woolston to modify Fishkin.

Accordingly, the rejection fails to make out a prima facie case of obviousness of the invention recited in claims 4, 5, 7 and 8. Thus, the rejection is improper, and should be withdrawn.

For the aforementioned reasons, the rejections of claims 1-10 are improper and should be withdrawn.

New claim 11 depends from claim 1 and is patentable at least for the reasons that claim 1 is patentable, as outlined above.

Accordingly, Applicants respectfully submit that claims 1-11 are patentable over the applied art and should be allowed.

Xerox Docket No. D/98003
Application No. 09/682,333

Should the Examiner believe that anything further is desirable to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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JAO:RJW/sxb

Attachment:
Replacement Sheet (Figs. 1 and 2)

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